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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/816,914 | 04/05/2004 | Toru Wada | 358362010601 | 2618 |

7590 12/14/2004

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| EXAMINER |
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HAMILTON, CYNTHIA

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| ART UNIT | PAPER NUMBER |
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1752

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,914

Applicant(s)

WADA ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-19, 22 and 24-26 is/are rejected.
- 7) ☒ Claim(s) 20,21,23 and 27-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/279,005.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/5/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 30 is objected to because of the following informalities: In line 2 of claim 30, "bonder" should be "binder". Appropriate correction is required.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Being able to determine specific values for (D) and (C) is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The examiner notes with respect to instant claim 9 that the definition of "rate of change in the radius of a halftone dot after IR ablation" is defined by applicants on pages 20-21. The variable A is the a half tone dot radius when (D), i.e. a certain value of laser energy is irradiated and B is the halftone dot radius when a laser energy value is changed to an optional value (C). This is the basis for claim 24 wherein there is no defining of the specific laser energy used for (D) or (C). Thus, applicants have not enabled a worker of ordinary skill in the art to determine when the unimaged unablated photosensitive resin laminate has the properties set forth by "rate of change in the radius of a halftone dot after IR ablation" because applicants have not made clear what (C) and (D) reference with regard to an unimaged, unablated laminate. Since the use of different lasers, speed of rotation of the cylinder being imaged, distance from plate by and time used of the laser effect these properties of dot size, the exact set of testing parameters for an un imaged un ablated

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plate would be necessary for a worker of ordinary skill in the art to determine if the plates they intended to use would read on applicants laminates. Thus, the "rate of change in the radius of a halftone dot after IR ablation" is an intended property as now defined for some system in which their laminate could be used. The examiner does not see how the "rate of change in the radius of a halftone dot after IR ablation" is an absolute of any laminate as a melting point is for a compound. Thus, how this test relates to an unimaged plate without knowing what lasers for (C) and (D) are chosen is non-enabling for this test in claim 24.

3.

4. The examiner has carefully read applicant's petition to make Special with respect to Teng especially. She agrees with applicant's arguments with respect to the non-IR-sensitive polymer resin layer between the IR absorbent metal layer and the cover film. The examiner also notes for clarification that in reading page 25 of applicant's specification wherein "opaque" is used as a noun, the wording of claim 21 makes sense. The phrase the examiner found unclear in examining the parent application in original claim 6 was as follows:

an opaque non-transparent to actinic radiation.

Claim 21 is as follows:

21. (New) The photosensitive resin laminate of claim 18, wherein the non-IR-sensitive polymer resin layer can receive an opaque non-transparent to actinic radiation.

The passage on page 25 of the specification of note is as follows:

When an image written by IR laser needs modification before the above-mentioned exposure of the entire surface to actinic radiation in the present invention, an opaque is applied onto the polymer resin layer to enable easy modification of the image. In one embodiment of the present invention, an organic polymer layer laminated on the metal layer can receive an opaque non-transparent to the actinic radiation. The opaque in the present invention is a substance that substantially prevents transmission of ultraviolet rays (actinic radiation). Examples thereof include oil-based ink, water-based ink, light blocking opaque tape and the like. Preferred is one having an optical density of not less than 2.0 for actinic radiation.

Thus, the "opaque" is defined and the intended use of the element set forth in claim 21 is clear.

The non-IR-sensitive polymer resin layer must be able to receive such an "opaque".

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 18-19, 22 and 25-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 and 13 of copending Application No. 10/279,005. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant applicant's claims are broader and more generic than are the Application claims. Thus, instant applicant's claims 18-19, 22 and 25-

26 are anticipated by claims 5-7 and 13 of the Application. See particularly See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). The amendment of April 5, 2004 in Parent Application 10/279,005 is the reference for the claims in question.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 20-21, 23, 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The examiner notes that the closest prior art to the now claimed element is that of Daems et al (2001/0038975 a1) in Example 2 wherein a subbing layer that is unidentified is the bismuth ablation layer and a PET support. It is noted that ablation occurs in Daems et al through the PET layer. However, the nature of the subbing layer is not set forth. There is no indication as to whether it ablates or not.

8. The examiner notes she has considered the one page PTO/SB/08 PTO-1449. Only one page not two was provided. The examiner crossed out the Parent application number and inked in the current application number.

9. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application

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of a CPA assigned the same application number. The examiner found no such statement in the Application Data Sheet or the specification or the Preliminary amendment. Applicants did in their Utility Patent Application Transmittal form claim continuation to prior application 10/279,005 but they have not amended their specification to meet all requirements necessary to perfect the benefit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cynthia Hamilton
Primary Examiner
Art Unit 1752

September 30, 2004

CYNTHIA HAMILTON
PRIMARY EXAMINER